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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/658,447	09/08/2003	Timothy Crowley	IP1806.0003	4731
83511 7590 12/17/2008 BRADFORD A. DONOVAN, P.L.L.C. 1126 NORTH SCOTTSDALE AVENUE, S TEMPE, AZ 85281				
EXAMINER				
MENON, KRISHNAN S				
ART UNIT		PAPER NUMBER		
1797				
MAIL DATE		DELIVERY MODE		
12/17/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/658,447

Applicant(s)

CROWLEY ET AL.

Examiner

Krishnan S. Menon

Art Unit

1797

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 November 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-6,13-64,69-71 and 112-131 is/are pending in the application.
- 4a) Of the above claim(s) 1,3-6,13-64 and 69-71 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 112-131 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claims 1, 3-6, 13-64, 69-71 and 112-131 are pending in the RCE of 11/13/08, of which claims 1,2-6,13-64, 69-71 are withdrawn from consideration. Claims 112 and 131 are independent.

Claim Rejections - 35 USC § 102/103

1. Claims 112-116, 120-123, 126, 127,130 and 131 are rejected under 35 U.S.C. 102(b) as being anticipated by Sundberg et al (US 6,090,251).

Sundberg teaches (see the figure below) an instrument having an input opening, a first passage (76), a filter in the first passage (labeled filter 1 in the fig reproduced below), a filtrate channel behind the filter 1, and plurality of parallel channels after the filter 1 leading from the first passage, which are tangentially past the filter 1.

Claim 131 recites "capillary action means" which is assumed as means plus function language, which invokes 35 USC 112, sixth paragraph, and therefore, what is disclosed by the applicant and equivalents thereof would read on the claim – the structure as claimed is anticipated by Sundberg as shown above.

The dependent claims recite characteristics of the liquid, which the reference is capable of handling, and would not form a patentable limitation in a device claim. Sundberg device is also part of an analytic system as in claims 126 and 127.

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2. Claims 112-131 are rejected under 35 U.S.C. 103(a) as unpatentable over Sundberg et al (US 6,090,251) and/or Ehrfeld et al (US 4,979,211) and/or Quake et al (US 2004/0248167) and/or Hillman et al (US 5,204,525).

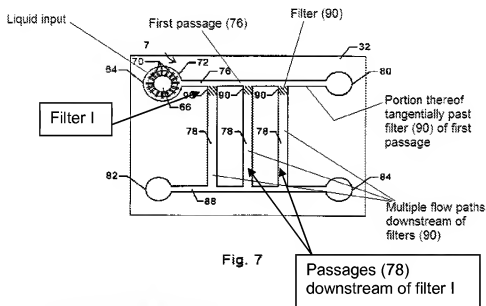


Fig 7 annotated with respect to claim 7.

Figure 7 of the reference is annotated with the elements of claim 7 to show how the claims read on the reference.

Sundberg teaches a microfluidic instrument in figure 7 comprising an input (70), a first passage (76), a tangential filter in the first passage (the first of the filter 90, which is a weir type filter – see figure 8), and multiple liquid flow paths (78) downstream of the filter as claimed: the subsequent channels (78) downstream of filter I (see figure above) read on this limitation, i.e., of the three channels (78) the second and third channels (78) are downstream and is tangentially past the first filter (90). Figure 7 shows only three

It would be obvious to one of ordinary skill in the art at the time of invention to use the teaching of Ehrfeld in the combination of references to increase the filtration capacity as can be understood from Ehrfeld.

With respect to having all the 'downstream capillary channels' in the first passage as downstream of all the filters, Hillman teaches capillary action pump having at least one capillary that can be used for pumping fluids (column 2, lines 50-60). Such capillary action pumps are also well known in the art (a forward and back search on the Hillman reference will show this). It would be obvious to one of ordinary skill in the art at the time of invention to use the teaching such as of Hillman in the combination of references or Sundberg for providing sufficient pumping forces for pumping the fluids through the filters. One would use the teaching of Hillman also because it affords constant flow rates without having to use additional means for flow control.

Claim 131 recites the means plus function language for capillary action, which is capillary action as disclosed in the specification (35 USC 112, sixth paragraph, means plus function language would be the corresponding disclosure or equivalents thereof). Sundberg teaches the structure recited in the claims as above.

Claim 126,127: several instruments, part of a device – see abstracts: microfluidic substrates; Sundberg column 1 lines 5-10 describe the invention as structure for introduction of fluids into devices.

Claims 113-116, 120-123, and 130:: the recitations in these claims, 'the complex fluid', blood, cell lysis, the flow times, filtrate quantities, and other 'instrument

requirements' are intended use, which are not patentable. The instrument taught by the reference is capable of all these. See also Sundberg column 9 lines 50-67.

Claims 117-119 recite details of electro-optical system. Quake teaches a laser-optic detection system (figures, abstract, col 7 lines 50-59). It would be obvious to one of ordinary skill in the art at the time of invention to use the teaching of Quake in the teaching of the combination of references for one of the various intended uses of the system for sample separation and analysis.

Claims 124, 125, 128, 129 have further limitations of certain dimensions of the channels. Sundberg teaches how to size the channels and optimize the instrument in column 9 line 50-column 10 line 38. Moreover, In *Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), cert. denied, 469 U.S. 830, 225 USPQ 232 (1984), the Federal Circuit held that, where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device. Also, Sundberg teaches channel widths, etc., in column 6 lines 9-25 with respect to the generation of capillary action. The length of the channels would depend of the filtration rate needed and the filter capacity, and can be optimized, or designed in. Quake teaches the length of the channels as about 1 μm to 2 cm, depending on the need for the analytical methods (see paragraph 187). It would be obvious to one of ordinary skill in the art at the time of invention to use the teaching of Quake in the teaching of the combination of references for analysis of the samples.

3. Claims 112-131 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Brody (US 5,922,210) and/or Ehrfeld et al (US 4,979,211) and/or Quake et al (US 2004/0248167) and/or Hillman et al (US 5,204,525).

Brody teaches an instrument comprising an input (1-figures), filter (5), passages from input to filter (4) and filter to output (6) all of which are capillary flow paths (inherent), and liquids flow by capillary action (inherent). Material is silicon wafers (example). Channel dimensions, separated particle sizes and fluid volumes – see column 3 lines 50-67, column 5 lines 4-25 and col 6 lines 13-25. the fluid to be treated, such as blood, and residence times (15 seconds), are intended use.

Ehrfeld teaches microfilters (42) straddling a first passage (50-51) having filtrate passages (47) as claimed – see figure 7 reproduced above:

Instant claims add the further limitation of plurality of fluid flow paths connected to the first passage to receive flow therefrom by capillary action and channel dimensions, which Brody does not teach. Quake teaches plurality of capillary flow paths (32) from a reservoir (48) (see - figure 1) which lead to an analyzer (50), and electro-optical means for testing (abstract); and channel dimensions such as length, width, etc in paragraph 153 and 187. It would be obvious to one of ordinary skill in the art at the time of invention to use the teaching of Quake in the teaching of Brody and/or Ehrfeld for the analysis of the filtered samples as taught by Brody or applications such as taught by Ehrfeld, for analysis such as DNA detection as taught by Quake. One of ordinary skill in

the art would also use the teaching of Brody or Ehrfeld to pre-filter the samples of Quake as taught by Brody for removing unwanted particulates.

Hillman teaches capillary action pump having at least one capillary that can be used for pumping fluids (column 2, lines 50-60). Such capillary action pumps are also well known in the art (a forward and back search on the Hillman reference will show this). It would be obvious to one of ordinary skill in the art at the time of invention to use the teaching such as of Hillman with the teaching of the other references for providing sufficient pumping forces for pumping the fluids through the filters, because Brody teaches that 'surface tension forces' can be used for such pumping. One would use the teaching of Hillman also because it affords constant flow rates without having to use additional means for flow control.

Response to Arguments

Applicant's arguments filed 11/13/08 have been fully considered but they are not persuasive. The new claims are broader than what were presented before.

Allowable Subject Matter

The following independent claim drafted by the examiner and presented to the applicant in the prior office action is repeated here for making this application in condition for allowance, with the suggestion that the additional limitations be presented in dependent claim form depending from this claim.

(New) An instrument for observation, treatment or analysis of a drop-size sample of a liquid comprising:

a liquid input opening for receiving the sample,

a first passage leading from the liquid input opening to an expanded liquid flow region,

at least one weir filter located tangentially along each side of the first passage between the input opening and the expanded region,

a filtrate channel located on each side of the first passage parallel to the first passage,

each weir filter in communication with the first passage and the filtrate channel located on the same side of the first passage as the weir filter, and

the expanded region comprising a plurality of parallel capillary channels sized to sustain the draw of sample through the first passage tangentially past the weir filters by capillary action.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Krishnan S. Menon whose telephone number is 571-272-1143. The examiner can normally be reached on 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David R. Sample can be reached on 571-272-1376. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Krishnan S Menon/
Primary Examiner, Art Unit 1797